

REMARKS

Claims 1, 4-14, 17-26, 28, 30-42, 44-51, 53, and 55-62 were pending in the application prior to the present Amendment. Claims 1, 12, 14, 24, 28, 30-42, 44-51, 53, 55, and 58 have been amended. Claims 26, 56, and 57 have been canceled. Claims 63-65 have been added. Claims 1, 4-14, 17-25, 28, 30-42, 44-51, 53, 55, and 58-65 remain pending after entry of the present Amendment. No new matter has been added.

Request for Continued Examination (RCE)

The application is under final rejection. An RCE is being filed concurrently herewith. Accordingly, Applicant respectfully requests withdrawal of the finality of the rejection and entry of the present Amendment.

Support for Amendments

Claim 1 has been amended to recite a device operable "in a first operational mode" and "in a second operational mode," the device comprising "an outer casing," a vibratory component "disposed within the outer casing for generating vibration at one or more of an available plurality of magnitudes," and "a probe projecting outwardly from the outer casing for transmitting vibration from the vibratory component to a subject." Claim 1 has additionally been amended to recite "a mode selector for selecting between the first operational mode of the device and the second operational mode of the device," the vibratory component being adapted to generate vibration in the second mode "at one or more selected magnitudes." Claim 1 has further been amended to no longer recite the vibratory component being adapted to generate vibration in the second mode at "one or more frequencies" and to no longer recited that the display is for indicating "the frequency of vibration." Support for the amendments can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIG. 1.

Claim 12 has been amended to more clearly recite the invention.

Claim 14 has been amended to recite a device "operable in a first mode and in a second mode," the device comprising "an outer casing," a vibratory component "disposed within the outer casing for generating vibration at one or more of an available plurality of

magnitudes and at least one frequency.” Claim 14 has additionally been amended to recite the component being adapted to generate vibration in the second mode “at a frequency and at one or more selected magnitudes.” Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIG. 1.

Claim 28 has been amended to recite providing a diagnostic device “operable in a first operational mode and a second operational mode,” the device comprising a component for generating vibration “at one or more of an available plurality of magnitudes.” Claim 28 has also been amended to recite steps of “selecting one or more magnitudes of vibration” and selecting the second mode “of the device to the exclusion of the first mode of the device.” Claim 28 has further been amended to recite “an outer casing enclosing the [vibration generating] component, and a probe extending outwardly from the outer casing, the probe being caused to vibrate by the component.” Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIGS. 1, 2, 3, and 5.

Claim 24 has been amended to more clearly recite the invention.

Claims 30 has been amended to conform with the amendment to claim 28, and to no longer recite generating vibration at a predetermined frequency.

Claims 31, 33, 35, 36, 38, 41, 48, and 50 have been amended to correct formalities.

Claims 32 and 34 have been amended to more clearly recite the invention, and to conform with the amendments to claims 28 and 30.

Claims 37 and 44 have been amended to more clearly recite the invention. Support for the amendments can be found in the original specification at least at paragraph [0041].

Claims 39 and 40 have been amended to conform with the amendments to claims 28 and 30.

Claim 42 has been amended to recite providing a diagnostic device “operable in a first operational mode and a second operational mode,” the device comprising a component for generating vibration “at one or more of an available plurality of magnitudes,” “an outer casing enclosing the component, and a probe extending outwardly from the outer casing, the probe being caused to vibrate by the component.” Claim 42 has also been amended to recite selecting the second mode “of the device to the exclusion of the first mode of the device.”

Claim 42 has further been amended to recite that the component is "further adapted to generate vibration at one or more selected magnitudes," and to no longer recite that the component is adapted to generate vibration at "one or more frequencies." Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIGS. 1, 2, 3, and 5.

Claims 45 and 46 have been amended to conform with the amendment to claim 42.

Claims 47 and 49 have been amended to more clearly recite the invention and to conform with the amendments to claims 42 and 46.

Claim 51 has been amended to recite providing a diagnostic device "operable in a first operational mode and a second operational mode," the device comprising a component for generating vibration "at one or more of an available plurality of magnitudes," "an outer casing, and a probe extending outwardly from the outer casing enclosing the [vibration generating] component, the probe being caused to vibrate by the component." Claim 51 has also been amended to recite selecting the second mode "of the device to the exclusion of the first mode of the device." Claim 51 has further been amended to recite applying the device to a subject and generating vibration "at one or more selected magnitudes." Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIGS. 1, 2, 3, and 5.

Claim 53 has been amended to recite providing a diagnostic device "operable in a first operational mode and a second operational mode," the device comprising a component for generating vibration "at one or more of an available plurality of magnitudes," "an outer casing, and a probe extending outwardly from the outer casing enclosing the [vibration generating] component, the probe being caused to vibrate by the component." Claim 53 has also been amended to recite selecting the second mode "of the device to the exclusion of the first mode of the device." Claim 53 has further been amended to recite applying the device to a subject and generating vibration "at one or more selected magnitudes," and to no longer recite that the component is adapted to generate vibration at "one or more selected frequencies." Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], [0037], [0038], and in FIGS. 1, 2, 3, and 5.

Claim 55 has been amended to recite the vibratory component being further adapted to generate vibration at a selected one or more of an available plurality of frequencies. Support for the amendment can be found in the original specification at least at paragraphs [0033], [0035], [0036], and in FIG. 1.

Claim 63 has been added to recite an embodiment of a device according to the invention. Support for the claim can be found in the specification at least at paragraphs [0014], [0020] to [0023], and [0033] to [0039], and in FIG. 1.

Claims 64 and 65 depend from claims 1 and 28, respectively, and recite "wherein the outer casing being isolated from the vibration generated by the vibratory component." Support for the amendments claims can be found in the original specification at least at paragraph [0037].

35 U.S.C. § 102(b) Rejection (MacDonald)

Claims 1, 4, 5, 12, 14, 17, 21, 24, 26, 55, 56, and 58 stand rejected as anticipated by U.S. Patent No. 5,93,161 (MacDonald). Claims 26 and 56 have been canceled.

The Examiner contends that MacDonald discloses all of the features recited in the independent claims 1 and 14, as well as the features of the specified respective dependent claims. Applicant respectfully disagrees.

It is hornbook law that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (quoting *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added)). MacDonald does not meet this test.

Claims 1 and 14 recite a device comprising an outer casing, a vibratory component disposed within the outer casing, and a probe projecting outwardly from the outer casing for transmitting vibration from the vibratory component to a subject.

Claims 1 and 14 also make clear that the device itself, and not solely the vibratory component, operates in two different modes and is adapted to generate vibration in each of those two modes, and that the device can be selected by a mode selector to operate in only

one mode at a time (i.e., in claim 1, the mode selector is for selecting between the first operational mode and the second operational mode, and in claim 14, the mode selector is for selecting one or the other of the first and second operational modes).

Claims 1 and 14 further make clear that the vibratory component can generate vibration at one or more of an available plurality of magnitudes. In the first operational mode of the device, the vibratory component is adapted to generate vibration in response to a remote wireless signal (e.g., the vibratory component is adapted to vibrate upon receipt of a remote wireless signal such as from an incoming cellular phone call or page). In the second operational mode of the device, the vibratory component is adapted to generate vibration one or more selected magnitudes for use in a medical diagnosis.

MacDonald does not teach each and every element of the claimed device.

MacDonald does not disclose an outer casing or probe as claimed

MacDonald does not teach a device having a probe for transmitting vibration from a vibratory component to a subject, the probe extending outwardly from an outer casing. In particular, MacDonald makes no mention of a probe for transmitting vibration extending outwardly from an outer casing the device. For example, the probe allows the claimed device to target the vibration generated by the vibratory component to a specific part of a subject's body for purposes of a medical diagnosis, as recited in claim 58.

MacDonald does not disclose two modes of operation or selection between two such modes

MacDonald does not teach a device having a vibratory component wherein the device has two modes of operation and is selectably operable in one or the other of two modes. The claimed device is adapted to operate in two operational modes, one of which can be selected at a time. In contrast, MacDonald teaches a "selectable call receiver [100] having a variable frequency vibrator" that is adapted to operate in only one mode, and to generate vibration in that one mode in response to receipt of a remote wireless signal. See MacDonald at col. 1, lines 55-68 (describing the one operational mode in which vibration is generated).

Applicant respectfully notes that the Examiner incorrectly cites MacDonald at col. 2, lines 37-41 for the proposition that the device has a selector for selecting either the first

operational mode or the second operational mode of the device. Because MacDonald's device has only one mode of operation, it would be impossible for the device to select between modes. Moreover, the cited passage merely describes one way in which the selectable frequency of the device can be varied; in particular, MacDonald teaches "varying the frequency" by "tuning a tuning element 130 (e.g., a tunable resistor) that is monitored by the controller 112." Thus, this teaching of MacDonald says nothing about the device itself being adapted to operate in two modes in which the vibratory component functions differently, and nothing about the device having a selector for selecting between two such modes.

MacDonald does not disclose selecting from an available plurality of magnitudes of vibration

Further, MacDonald does not teach a vibratory component for generating vibration at one or more of an available plurality of magnitudes. Still further, MacDonald does not teach a vibratory component wherein in a second of the operational modes of the device, the vibratory component is adapted to generate vibration at one or more selected magnitudes.

Claims 1 and 14 recite a vibratory component for generating vibration one or more of an available plurality of magnitudes, the vibratory component being adapted to generate vibration in the second mode "at one or more selected magnitudes." In contrast, MacDonald teaches a device in which, while operating in its one and only mode, the frequency of vibration (but not the magnitude of vibration) can be varied by way of a frequency selector 120. See MacDonald at col. 2, lines 1-4, and Figs. 1 and 2.

MacDonald's device does not have a vibratory component that can generate vibration at one or more of an available plurality of magnitudes; MacDonald is concerned only with varying the frequency of vibration of the device and not with varying the magnitude of vibration. It is well known by one of ordinary skill in the art that magnitude and frequency are distinct properties that are not interchangeable; for example, a radio for receiving AM (amplitude modulated) signals cannot be interchangeably adapted to receive FM (frequency modulated) signals. The only mention of the magnitude of vibration in MacDonald is with regard to detecting a decrease in battery power. See MacDonald at col. 2, lines 21-29. Thus,

in MacDonald's device, only the frequency of vibration is subject to being varied in order to enable a user to differentiate between vibratory signals.

No other cited references remedy the deficiencies of MacDonald

No other reference cited by the Examiner teaches a device having a probe extending outwardly from a casing, wherein the probe transmits vibration from a vibratory component disposed within the casing, the device having two mutually independent modes of operation and a vibratory component for generating vibration at one or more of an available plurality of magnitudes, wherein the magnitude of vibration in a second mode of operation of the device can be one or more selected magnitudes. Therefore, it would not be possible to modify the teachings of MacDonald based on the teachings of another reference to formulate an obviousness rejection of the claimed device as recited in claims 1 and 14.

In sum, MacDonald does not anticipate independent claims 1 and 14. Claims 4, 5, 12, 55, and 58 depend from claim 1; therefore, without prejudice to their individual merits, claims 4, 5, 12, 55, and 58 are patentable over MacDonald for at least the same reasons as claim 1. Claims 17, 21, and 24 depend from claim 14; therefore, without prejudice to their individual merits, claims 17, 21, and 24 are patentable over MacDonald for at least the same reasons as claim 14.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 4, 5, 12, 14, 17, 21, 24, 55, and 58 be withdrawn.

35 U.S.C. § 102(b) Rejection (Mechaber)

Claims 28, 36, 41, 42, 45, 51, and 53 stand rejected as anticipated by a one-paragraph practice tip entitled "Vibrating pager tests nerves" written by Alex Mechaber, MD and published in Postgraduate Medicine, Vol. 104, No. 1, July 1998 (Mechaber).

The Examiner contends that Mechaber discloses all of the features recited in the independent claims 28, 42, 51, and 53, as well as the features of the specified respective dependent claims. Applicant respectfully disagrees.

It is hornbook law that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference.” MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added)). Mechaber does not meet this test.

In particular, the MPEP is clear that the claimed invention as a whole must be considered. MPEP § 2141.02(I). It is impermissible to distill an invention down to the “gist” or “thrust” of the invention, because doing so disregards the requirement of analyzing the subject matter as a whole. MPEP § 2141.02(II). Yet by setting forth an anticipation rejection based on the scant disclosure of Mechaber, the Examiner has done just that. While Mechaber’s practice tip may capture the general gist or idea of using a vibrating pager to detect neuropathy, it falls far short of disclosing the invention as a whole, including each and every element recited in the claims.

Mechaber does not disclose providing a device with an outer casing or probe as claimed

Claims 28, 42, 51, and 53 recite a method including providing a device comprising an outer casing enclosing a component for generating vibration, and a probe extending outwardly from the outer casing, the probe being caused to vibrate by the component. In contrast, Mechaber discloses a method of using an ordinary pager. A person of ordinary skill in the art would readily understand that an ordinary pager, such as that used by Mechaber, does not have a probe extending outwardly from the casing for transmitting vibration from the vibratory component to a subject, a feature that allows the claimed device target the vibration generated by the vibratory component to a specific part of a subject’s body for purposes of a medical diagnosis. In contrast, a person of ordinary skill in the art would understand a conventional pager to intentionally transmit the vibration generated by the vibratory component to the outer casing, and not specifically directed to a probe, to most effectively alert a user of an incoming page. Thus, Mechaber’s method is understood as including a step of contacting the outer casing of a pager with a patient, the outer casing also transmitting vibration to the fingers and hand of a physician or other person applying the pager to the patient.

Mechaber does not disclose providing a device having two operational modes

Claims 28, 42, 51, and 53 make clear that the method includes providing a device that is operable in a first operational mode and a second operational mode, wherein the device can operate in only one of the first and second modes at a time (i.e., "selecting the second mode of the device to exclusion of the first mode of the device"), the device having a component for generating vibration at one or more of an available plurality of magnitudes, the component being adapted to generate vibration in the first mode in response to a remote wireless signal and in the second mode for use in medical diagnosis. In contrast, the standard pager that is used by Mechaber has only one "vibratory mode" in which it can generate vibration. (Applicant respectfully submits that when Mechaber describes setting the pager "on vibratory mode," it is understood by one of skill in the art that the possible alternative mode(s) would be an "auditory mode" or the like, where an audible ringer would sound to alert the user to an incoming page, and a "silent mode" in which no audible or vibratory signal is generated. A pager known to one of ordinary skill in the art does not, and did not in 1998, or in 2003 when the present application was filed, have more than one vibratory mode.) Thus, Mechaber fails to disclose providing a device having selectable first and second operational modes of the device, such that the device can be selected to operate in the second mode to the exclusion of the first mode, and wherein the device can vibrate in each of the first and second operational modes.

Mechaber does not disclose selecting one or more of a plurality of magnitudes of vibration

Claim 28 recites a step of selecting one or more magnitudes of vibration to be used in medical diagnosis. In contrast, the device used by Mechaber is not adapted to generate one or more of an available plurality of magnitudes of vibration or to enable selection one or more of those magnitudes of vibration.

Similarly, claim 42 recites providing a device having a component for generating vibration at one or more of an available plurality of magnitudes, the component being adapted to generate vibration at a selected one or more magnitudes in the second mode. In contrast, the device provided by Mechaber cannot generate a plurality of magnitudes of

vibration and is not adapted to generate vibration at one or more magnitudes of vibration selected from the available plurality of magnitudes.

Further, claims 51 and 53 each recite providing a device having a component for generating vibration at one or more of an available plurality of magnitudes and a step of applying the device to a subject and generating vibration at one or more selected magnitudes. In contrast, the method of Mechaber does not include selecting and generating one or more of such a plurality of magnitudes of vibration.

No other cited references remedy the deficiencies of Mechaber

No other reference cited by the Examiner teaches method that includes providing a device having a probe extending outwardly from a casing, wherein the probe transmits vibration from a vibratory component disposed within the casing, the method including providing a device having two mutually exclusive operational modes, wherein the device is adapted to generate vibration one or more of an available plurality of magnitudes and to further generate vibration at one or more selected magnitudes of the plurality of available magnitudes in the second operational mode. Similarly, no other reference cited by the Examiner teaches a method having a step of selecting one or more of a plurality of magnitudes of vibration in the second mode. Therefore, it would not be possible to modify the teachings of Mechaber based on the teachings of another reference to formulate an obviousness rejection of the claimed device as recited in claims 28, 42, 51, and 53.

In sum, Mechaber does not anticipate independent claims 28, 42, 51, and 53. Claims 36 and 41 depend from claim 28; therefore, without prejudice to their individual merits, claims 36 and 41 are patentable over Mechaber for at least the same reasons as claim 28. Claim 45 depends from claim 42; therefore, without prejudice to its individual merits, claim 45 is patentable over MacDonald for at least the same reasons as claim 42.

Accordingly, Applicant respectfully requests that the rejection of claims 28, 36, 41, 42, 45, 51, and 53 be withdrawn.

35 U.S.C. § 103(a) Rejection (LaCourse in view of Mault)

Claims 1, 4-14, 17-26, 28, 30, 32, 34, 36-42, 44-47, 49, 51, 53, and 55-58 stand rejected as obvious under U.S. Patent No. 5,002,065 (LaCourse) in view of U.S. Patent No 6,478,736 (Mault). Claims 26, 55, and 56 have been canceled. Applicant traverses the rejection of the remaining claims because this combination of references does not result in the claimed invention.

In making a case for obviousness, the Examiner must: (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims at issue; (3) resolve the level of ordinary skill in the pertinent art; and (4) evaluate evidence of secondary considerations. *Graham v. John Deere*, 383 U.S. 1 (1960); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

When applying 35 U.S.C. § 103, the following tenets of patent law must be followed: (1) the claimed invention must be considered as a whole; (2) the references must be considered as a whole; (3) the references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and (4) the standard for determining obviousness is a reasonable expectation of success. MPEP § 2141.

Official Notice is not Appropriate for Facts Regarding the State of Art and for Facts Not Capable of Instant and Unquestionable Demonstration as Being Well-Known

In forming a rejection based on LaCourse in view of Mault, the Examiner has taken official notice of the alleged facts that: "Cellular phones are known to have a vibratory component that generates a vibration in response to a remote wireless signal in a first mode (when a call is received) and to produce a vibration in a second mode (when a scheduled alarm goes off). Cellular phones are also known to have a mode selector (i.e., a menu) for selecting between the first and second modes." Office Action of August 21, 2008 at page 4.

Applicant respectfully traverses the taking of official notice of these facts regarding state of the art as inappropriate without supporting documentary evidence. MPEP § 2144.03(C). Applicant, as one of skill in the art, is not aware of a cellular phone today, and was certainly not aware of one prior to December 3, 2003, having two mutually exclusive operating modes wherein a vibratory component is adapted to generate vibration in each of

the two modes; also, Applicant is not, and was not at the time of filing of the present application, aware of a cellular phone having a mode selector to select between two such operational modes of the cellular phone.

As a basic matter, Applicant respectfully reminds the Examiner that for a reference or an officially noticed fact to be relevant prior art in the present application, that reference or officially noticed fact must disclose the state of the art as of the filing date of December 3, 2003. Therefore, it is irrelevant whether cellular phones in August of 2008 “are known to have” any particular features, because such a fact has no bearing on whether cellular phones did have the same or similar features prior to December 3, 2003. Accordingly, the Examiner has failed to set forth a *prima facie* case based on the officially noticed facts, because the filing date of the present application antedates those alleged facts.

Moreover, even if the Examiner had asserted that such features were in existence in cellular phones as of the filing date of the present application, Applicant respectfully submits that it is not appropriate to take official notice of these facts, unsupported by documentary evidence. “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03(A); *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (notice of facts beyond the record must be “capable of such instant and unquestionable demonstration as to defy dispute”).

Further, it is inappropriate to take official notice of facts relating to the state of the art at the time of the invention. *In re Eynde*, 480 F.2d 1364, 1370 (CCPA 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.”)

Rather, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known.” MPEP § 2144.03(A). The facts of which the Examiner has taken official notice do not meet this test, for at least the reason that Applicant, as one of skill in the art, disputes those facts as not being capable of

instant and unquestionable demonstration as being well-known, and indeed respectfully submits that if these facts are so well known then the Examiner should be able to produce a reference, i.e., documentary evidence, of those facts.

Moreover, “[i]f such notice is taken, the basis for such reasoning must be set forth explicitly.” MPEP § 2144.03(B). The Examiner has not done so. “The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusions of common knowledge.” MPEP § 2144.03(B) (additionally noting that “[t]he applicant should be presented with the explicit basis on which the examiner regard the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the office action in which the common knowledge statement was made”). Applicant especially directs the Examiner’s attention to the provision that the “circumstances [when official notice is relied on] should be rare when an application is under final rejection,” and as a result, the applicant has limited opportunity to respond. MPEP § 2144.03(A).

Because Applicant has adequately traversed the facts of which the Examiner has taken official notice by specifically pointing out the errors in the Examiner’s action and stating why the notice facts are not well-known to one of skill in the art, “the examiner must provide documentary evidence in the next office action if the rejection is to be maintained.” MPEP § 2144.03(C) (citing 37 C.F.R. § 1.104(c)(2); *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (noting that the substantial evidence test requires that “the Board [or the examiner] must point to some concrete evidence in the record [for] support”))).

LaCourse in view of Mault does not teach or suggest an outer casing or probe as claimed

Independent device claim 1 recites an outer casing, a vibratory component disposed within the outer casing, and a probe projecting outwardly from the outer casing for transmitting vibration from the vibratory component to a subject. Independent device claim 14 recites an outer casing, a vibratory component disposed within the outer casing, and a probe for transmitting vibration from the vibratory component to a subject. Similarly, independent method claims 28, 42, 51, and 53 recite providing a device comprising a component for generating vibration, an outer casing enclosing the component, and a probe

extending outwardly from the outer casing, the probe being caused to vibrate by the component.

The combination of LaCourse in view of Mault further in view of facts officially noticed by the Examiner, does not disclose, teach, or suggest these claimed features. In particular, because neither LaCourse nor Mault discloses a portable device having a component for generating vibration, the Examiner relies heavily on officially noticed facts concerning the properties of cellular phones currently on the market. As discussed above in Applicant's traversal of the taking of official notice, the Examiner does not assert anything with regard to cellular phones existing prior to or at the time of the filing of the patent application (i.e., December 3, 2003), which is the relevant time period on which prior art must be based. Accordingly, Applicant respectfully request that the Examiner provide evidence, rather than taking official notice, that the asserted features were present in a cellular phone prior to or at the time the present patent application was filed in order to substantiate the contention that a device with such features existed in the prior art that is pertinent to the examination of the present application.

Moreover, even if the Examiner's contentions can be substantiated in the prior art (a point not conceded by Applicant), Applicant respectfully submits that it is well known in the art that cellular phones do not, and did not as of December 3, 2003, have a probe extending from the casing wherein the probe transmits vibration from the vibratory component disposed within the casing. Indeed, it is well known by one of ordinary skill in the art, as well as an ordinary cellular phone owner or user, that the vibration generated by the vibratory component in such a cellular phone is not concentrated to a probe but instead is transmitted to the entire outer casing, since the purpose of the vibration is to alert a user of an incoming call or page by causing the outer casing of the cellular phone to vibrate. Therefore, it would have been nonobvious and would have gone against the understanding of person of ordinary skill in the art at the time of Applicant's invention, based on LaCourse in view of Mault and the officially noticed facts, to provide a probe for transmitting the vibration generated by the vibratory component to a subject. Further, it would have been nonobvious to focus the vibrations onto such a probe extending outwardly from the casing for use in diagnosing a medical condition.

LaCourse in view of Mault does not teach or suggest selecting between operational modes

In addition, independent device claim 1 recites a mode selector for selecting between a first operational mode of the device and a second operational mode of the device. Similarly, independent device claim 14 recites a selector for selecting one or the other of a first operational mode of the device and a second operational mode of the device. Further, independent method claims 28, 42, 51, and 53 each recite a step of selecting the second mode of the device to the exclusion of the first mode of the device. Thus, it is clear that all of the pending claims require a device, or a method including providing a device, that has two mutually exclusive modes of operation between which a user can select. Moreover, in each of the two mutually exclusive modes, a vibratory component is adapted to generate vibration that is differently characterized depending on the operational mode of the device. In particular, Applicant's claimed device operates in two distinct selectable modes because it uses the same vibratory component to generate vibration in each of the two modes, i.e., a user of Applicant's device cannot be simultaneously used for diagnosing a medical condition and for generating vibration in response to a remote wireless electronic signal.

The combination of LaCourse and Mault, further in view of alleged facts of which the Examiner has taken official notice, does not teach such a device or method. LaCourse does not disclose a device having a first operational mode and a second operational mode, much less first and second operational modes that are mutually exclusive. Indeed, the Examiner concedes that LaCourse has only one operational mode and relies on Mault to teach more than one operational mode. However, while Mault is asserted to teach more than one operational mode (col. 6, lines 4-9), there is no indication that these modes are mutually exclusive. Rather, it would be understood by a person of ordinary skill that the Mault device is adapted to operate simultaneously as both a health management system and a remote wireless electronic communication device, e.g., a user can use the device to monitor metabolic rate and at the same time use the device as a cellular phone.

Further, beyond the fact that Mault does not teach mutually exclusive operational modes, Mault does not teach or even contemplate a vibratory component or any means for generating vibration, and indeed makes no mention of a vibratory component or vibration.

Mault teaches an integrated calorie management system that has no use or need for vibration or a vibratory component. Mault does not even disclose that the calorie management system generates an alarm or an alert of any sort, much less one that is communicated to a user via vibration. Thus, Mault is a nearly irrelevant reference which is used solely to provide the link between the unifunctional device of LaCourse and a cellular phone based Mault's teaching of a multi-functional medical diagnostic device that could also be used as a cellular phone (col. 6, lines 13-20). Otherwise, Applicant respectfully submits that the rejection appears to be founded on LaCourse in view of the officially noticed facts regarding cellular phones.

Moreover, neither Mault nor the officially noticed facts regarding cellular phones disclose two mutually exclusive vibrational modes of operation. When using the device of Mault, or a cellular phone as described by the Examiner, a user need not "select between" or "select one or the other of" the modes set forth in the rejection. Rather, in a cellular phone as described by the Examiner, both modes can operate substantially simultaneously. In one example, it is well known that when an alarm is set on a cellular phone or similar device, the cellular phone can be used for remote voice communications during the same time period the alarm is pending, and indeed the alarm can go off in the middle of a telephone conversation or while a call is being placed or received. In another example, it is well known that while an alarm that was previously set on a cellular phone is going off, an incoming call can cause the cellular phone to ring by triggering its vibratory component. In contrast, the claimed device cannot be operated in both modes at the same time; when the device is in the first operational mode, the vibratory component generates vibration in response to a remote wireless signal, and when the device is in the second operational mode, the vibratory component generates vibration at a selected one or more of a plurality of magnitudes for use in medical diagnosis.

LaCourse in view of Mault does not teach or suggest vibration at selected magnitude(s)

Additionally, claims 1 and 14 have been amended to recite that the vibratory component generates vibration in the second mode at "one or more selected magnitudes" "of an available plurality of magnitudes," and claim 42 has been amended to recite a step of providing a device having such a component. Similarly, claim 28 has been amended to recite

a step of "selecting one or more [of an available plurality of magnitudes] of vibration to be used in medical diagnosis," and claims 51 and 53 have each been amended to recite a step of "generating vibration at one or more selected magnitudes." The combination of LaCourse and Mault, further in view of alleged facts of which the Examiner has taken official notice, does not teach a device or method having such a feature.

Claimed device and method are nonobvious over LaCourse in view of Mault

In sum, the combination of LaCourse and Mault, in view of the officially noticed facts regarding cellular phones, does not disclose or render obvious a device having an outer casing, and a probe extending outwardly from the casing for transmitting vibration generated by a vibratory component. Further, LaCourse in view of Mault and the officially noticed facts does not disclose or render obvious a device having two mutually exclusive operating modes, the device having a vibratory component adapted to generate vibration in response to a wireless signal in the first mode and further adapted to generate a selected one or more of an available plurality of magnitudes of vibration in the second mode. Similarly, the combination of references does not teach or render obvious a method using such a device and including a step of selecting one or more of an available plurality of magnitudes of vibration in the second mode. Therefore, claims 1, 14, 28, 42, 51, and 53 are not rendered obvious by LaCourse in view of Mault further in view of the additional officially noticed facts.

Claims 4-13, 55 and 58 depend from claim 1; therefore, without prejudice to their individual merits, claims 4-13, 55, and 58 are patentable over LaCourse in view of Mault for at least the same reasons as claim 1. Claims 17-25 depend from claim 14; therefore, without prejudice to their individual merits, claims 17-25 are patentable over LaCourse in view of Mault for at least the same reasons as claim 14. Claims 30, 32, 34, and 36-41 depend from claim 28; therefore, without prejudice to their individual merits, claims 30, 32, 34, and 36-41 are patentable over LaCourse in view of Mault for at least the same reasons as claim 28. Claims 44-47 and 49 depend from claim 42; therefore, without prejudice to their individual merits, claims 44-47 and 49 are patentable over LaCourse in view of Mault for at least the same reasons as claim 42.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 4-14, 17-25, 28, 30, 32, 34, 36-42, 44-47, 49, 51, 53, 55, and 58 be withdrawn.

35 U.S.C. § 103(a) Rejection (LaCourse in view of Mault further in view of Laudadio)

Claims 31, 33, 35, 48, 50, and 59-61 stand rejected as obvious under U.S. Patent No. 5,002,065 (LaCourse) in view of U.S. Patent No 6,478,736 (Mault) further in view of U.S. Patent No. 5,931,793 (Laudadio). Applicant traverses the rejection because the combination of references does not result in the claimed invention.

As discussed above, the combination of LaCourse and Mault with the additional officially noticed facts fails to disclose all of the elements of Applicant's claimed invention, as recited in independent claims 1, 14, 28, 42, 51, and 53. Laudadio does not remedy the deficiencies in LaCourse and Mault. In particular, Laudadio does not disclose a device having two mutually exclusive operating modes, the device having a vibratory component adapted to generate vibration in response to a wireless signal in the first mode and further adapted to generate a selected one or more of an available plurality of magnitudes of vibration in the second mode.

Claims 31, 33, and 35 depend from claim 28; therefore, without prejudice to their individual merits, claims 31, 33, and 35 are patentable over the combination of LaCourse, Mault, and Laudadio for at least the same reasons as claim 28. Claims 48 and 50 depend from claim 42; therefore, without prejudice to their individual merits, claims 48 and 50 are patentable over the combination of LaCourse, Mault, and Laudadio for at least the same reasons as claim 42. Claims 59-61 depend from claim 1; therefore, without prejudice to their individual merits, claims 59-61 are patentable over the combination of LaCourse, Mault, and Laudadio for at least the same reasons as claim 1.

Accordingly, Applicant respectfully requests that the rejections of claims 31, 33, 35, 48, 50, and 59-61 be withdrawn.

New Claims

Newly added independent claim 63 recites a device having a combination of features not disclosed in any of the references cited by the Examiner, whether taken alone or in combination. Accordingly, Applicant respectfully submits that claim 63 is allowable.

Newly added dependent claim 64 depends from claim 1 and recites that the outer casing is isolated from the vibration generated by the vibratory component. Both on its own merits and by virtue of its dependence from claim 1, claim 64 is allowable over the prior art cited by the Examiner.

Newly added dependent claim 65 depends from claim 28 and recites that the outer casing is isolated from the vibration generated by the vibratory component. Both on its own merits and by virtue of its dependence from claim 28, claim 65 is allowable over the prior art cited by the Examiner.

CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. Withdrawal of all rejections, and allowance of the application, including claims 1, 4-14, 17-25, 28, 30-42, 44-51, 53, 55, and 58-65, is respectfully requested. An early notice of allowance is earnestly solicited.

Respectfully submitted,

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